



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,529	08/23/2003	Viggo L. Norum	GS 0492 F	8490
20676	7590	03/29/2005	EXAMINER	
ALFRED J MANGELS 4729 CORNELL ROAD CINCINNATI, OH 452412433			LEWIS, TISHA D	
		ART UNIT		PAPER NUMBER
		3681		

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JB

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/646,529	NORUM ET AL.	
	Examiner TISHA D. LEWIS	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 14, 18, 21, 22, 29-36, 40, 48-53 and 55 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13, 15, 17, 19, 20, 23-28, 37-39, 41-47, 54 and 56-69 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

## **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/646,529 filed on August 23, 2003.

### ***Election/Restrictions***

Claims 14, 21, 22, 29-32, 34, 35, 40, 48-53 and 55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 6, 2005.

Applicant's election with traverse of Group II in the reply filed on January 6, 2005 is acknowledged. The traversal is on the ground(s) that all claims should be examined since claim 1 is generic. This is not found persuasive because the remainder of the claims are directed to different patentably distinct species from generic claim 1 in which a search for one species would not require the same search for the other species.

The requirement is still deemed proper and is therefore made FINAL.

Also, claims 18, 33, 36 and 40 are withdrawn as being drawn to a nonelected species.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement filed on January 26, 2004 has been acknowledged.

***Claim Objections***

Claims 1, 2, 19, 20, 39, 41, 47 and 67 are objected to because of the following informalities:

- In claim 1, last line, after "final", "actuation" should be changed to --output--.
- In claim 2, line 7, after "final", "actuation" should be changed to --output--.
- In claim 19, line 4, after "second functional", "element" should be changed to --area--.
- In claim 20, line 5, "are" should be changed to --area--.
- In claim 39, line 3, "these" should be changed to --them--.
- In claim 41, line 3, before "final", --said-- should be inserted.
- In claim 41, line 3, before "primary", --a-- should be inserted.
- In claim 47, line 4, "notion" should be changed to --motion--.
- In claim 67, line 1, "56" should be changed to --66--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-13, 15-17, 19, 20, 23-28, 37-39 and 61-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 19, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 58, line 4, it is unclear as to what the term "latter" is referring to.

Regarding claim 61, line 2, it is unclear as to what the term "respectively" is being used for.

Regarding claims 61, 62 and 65, it is unclear as to what the terms "a likely", "the likely" or "the like" is referring to.

Regarding claim 61, line 2 recites "one transmission shaft", line 3 recites "the transmission input shaft, line 5 recites "a first transmission input shaft" and line 6 recites "the second transmission input shaft. It is unclear as to how many shafts are being claimed and at least the shafts on lines 3 and 6 are lacking antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 41-46, 54, 56, 57 and 59 rejected under 35 U.S.C. 102(b) as being unpatentable by Malott ('251). As to claim 1, Malott discloses a transmission having a plurality of sets of gears having ratio steps with a first gear non-rotatably connected to a first shaft and an idler gear connected to a second shaft (Figure 1) and connecting both gears by a final output mechanism (Figures 4 and 5) bearing on a shaft (128) wherein

the shift sequence of the ratios are established after the final output element shifts the gears for engagement.

As to claims 41-46, Malott discloses a linear path of engagement between the output element (i.e., 68) and the primary actuation element (B, C or D), a non-linear path of engagement between output element (i.e., 44) and the primary element (A), linear and non-linear paths between the output element and secondary actuation elements (Figures 9-14) wherein the ratio steps can overlap in disengagement.

As to claim 54, Malott discloses the output elements forming two groups along an axis of rotation (one on input shaft and other on output shaft).

As to claims 56, 57 and 59, Malott discloses the primary actuation elements being brought to a neutral position with disengagement of all gears by the secondary elements (cams) wherein the position is reached by a selection motion of a lever between the output elements.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15-17, 19, 20, 23-28, 37-39, 41-47, 54 and 56-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Pels et al ('247). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Pels discloses a double clutch transmission having the limitations of the above claims cited in column 45, line 23 to column 56 and shown in Figures 23-35.

### FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to  
the Patent and Trademark Office (Fax No. (703) 000-0000) on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Reik et al ('362) and Haka ('157).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TdI  
March 20, 2005

*Tisha Lewis*  
TISHA LEWIS  
PRIMARY EXAMINER  
All 3681 3/20/05